

Application No.: 10/664,426

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REMARKS

Claims 22-24 are currently pending. In view of the comments below, reconsideration of the present application is respectfully requested.

Applicants' Response to Rejection of Claims Under 35 U.S.C. §103

Claims 18-21 have been rejected under 35 U.S.C. §103 as allegedly unpatentable over 4,250,196 to Friello ("Friello") in view of U.S. Patent No. 3,062,662 to McDonald. Applicants respectfully traverse these rejections on the grounds that the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, the references include no motivation to modify or combine the references, the teachings of the references are not properly combinable, and even if combined, the references fail to teach the invention as claimed. Therefore, reconsideration and withdrawal of the rejections are respectfully requested.

The present invention includes a three-material confection which includes a center layer of a semi-liquid material, an intermediate layer of a gum material and an outer layer of a hard candy material. The candy may also be in the form of a lollipop. The present invention has prepared this lollipop product by addressing and compensating for the issues related to center-fill gums, such as leaking and liquid migration from the center-fill which results in a non-liquid center.

M.P.E.P §2143 states the "Basic Requirements of a *Prima Facie* Case of Obviousness. In order to establish a *prima facie* case of obviousness, (1) a reference or combination of references must provide some suggestion or motivation to modify the reference or to combine the teachings; (2) there must be a reasonable expectation of success; and (3) there must be a teaching or suggestions of all claim limitations. The teachings must consider the reference as a whole and the proposed modification cannot render the prior art unsatisfactory for its intended purpose.

The deficiencies of the references to establish a *prima facie* case of obviousness are: (1) neither Friello nor McDonald includes any teaching or suggestion to modify or combine the

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references; (2) even if the teachings of Friello and McDonald are combined, they would not result in a three layered confection as in the present invention; and (3) neither Friello nor McDonald teaches a gum layer which is a separate layer surrounded by a hard candy layer.

Friello teaches a center-filled gum composition having a liquid center. The formulation of the center-fill allows for the use of an aqueous solution including a hydrogenated starch hydrolysate which avoids the need for addition of glycerin. Friello recognizes the inherent problems of providing a commercially acceptable center-filled gum such as potential leaking and hardening of the center-fill. The focus of the teachings of Friello is to provide an acceptable gum product which provides the benefit of a liquid center gum to the consumer. Friello provides no teaching or suggestion to add any coating to the gum composition, nor how such a coating may be accomplished.

McDonald is cited for teaching a combination of chewing gum and candy in a lollipop form. McDonald prepares this confection by inserting a lollipop stick into a gum piece and then dipping the gum into a hot candy syrup. The gum must stay in the syrup for a sufficient time "so that the bubble gum will partially melt and soften and mix with the candy." Column 2, lines 54-55. The purpose of McDonald is to provide a combination of candy and gum where "the candy composition intermixes with a substantial part of the bubble gum material." Column 1, lines 35-36.

The Examiner states at page 2 of the Office Action date August 26, 2005 that the motivation to combine the references is "in order to provide the product with an additional appealing texture and/or flavor and also to extend the period of time over which the produce could be enjoyed." This teaching is not found in either Friello or McDonald, but instead is the purpose of the present invention and in effect is nothing more than impermissible hindsight reconstruction. It is well-settled as expressed in MPEP §2143, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."

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As the Board has stated,

...we note that it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious. We additionally note that a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

Ex parte Haymond, 41 U.S.P.Q.2d 1217, 1220 (B.P.A.I. 1996) (citation omitted).

Considering that neither Friello nor McDonald provides motivation to modify the teachings therein to provide a hard candy coating on a liquid filled chewing gum, the combination of Friello and McDonald fails to establish a *prima facie* case of obviousness.

The second requirement for establishing a *prima facie* case of obviousness is that the references must provide a reasonable expectation of success. In the Office Action dated August 26, 2005, at pages 2-3, the Examiner does not seem to acknowledge this criteria. Instead, the Examiner states:

the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; not is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*; 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicants do not deny that what the teachings of a reference suggest to those of ordinary skill in the art is an important consideration. However, this does not negate the requirement that there must be a reasonable expectation of success. One following the teachings of the references will not achieve the product of the present invention. Therefore, there is no reasonable expectation of success.

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As pointed out in the response dated July 11, 2005, even if one were to combine the teachings of McDonald with Friello, one could not expect to achieve a successful candy-coated center-filled product as in the present invention. McDonald does not contemplate the inclusion of a center-filled gum and therefore does not accommodate for the potential issues of leaking of the center. Melting the gum layer as required by McDonald would lead to leaking of the liquid center which is contained by the gum, not to mention the likelihood of eliminating the separate intermediate gum layer, as it would be combined with the hard candy.

McDonald requires the combination of a gum with the candy by melting the gum and candy together. McDonald is concerned only with solid gum centers which are dipped into hot (300 – 310F) candy syrup. It is clear from the teachings of McDonald that this dipping process was not intended for liquid-center-filled gums since to allow partial melting and softening of the candy with the gum and to impregnate the gum with hard candy crystals will jeopardize the integrity of the center-filled gum. Prevention of center fill leaking is addressed in Friello's requirement for a water impenetrable gum base (see column 5, lines 15-16). Impregnating the gum with hard candy crystals as in McDonald would provide a water penetrable gum base material. As the Examiner is aware, there are many difficulties in producing and maintaining commercially viable center-filled gums and one of ordinary skill in the art would avoid processes which might introduce additional problems such as premature migration. Thus one of ordinary skill in the art would not employ the process as taught by McDonald to coat a center-filled gum since using the method of McDonald would not provide one of ordinary skill in the art with a reasonable expectation of success.

Also, as discussed above, neither McDonald nor Friello provides a teaching or suggestion to provide a hard candy layer and an intermediate gum layer. The only teaching of a hard candy in combination with a gum layer is found in McDonald, wherein there are not two layers, but to the contrary, the gum and hard candy are mixed.

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For the reasons set forth above, there is no motivation in any of the references to combine the teachings of each. Even if combined, the references would not lead one of ordinary skill in the art to prepare the invention of the present claims.

In view of the above amendments and remarks, Applicants respectfully submit that the present application, including claims 22-24 is now in condition for allowance. Favorable action thereon is respectfully requested.

Should the Examiner have any questions with respect to the above amendments and remarks, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the telephone number below.

Respectfully submitted,



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